

AMENDMENT AFTER FINAL ACTION

Appln. No. 10/686,353

Docket No. 066491-00007

REMARKS

Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 are pending in the application. Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0092203 to Hardt ("the Hardt '203 publication") in view of U.S. Patent No. 5,218,056 to Santiyanont et al. ("Santiyanont '056").

Rejection of all claims under § 103(a) over the Hardt '203 publication in view of Santiyanont '056

Claims 1-3, 8-9, 11, 17-27, 32-35, and 37-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hardt '203 publication in view of Santiyanont '056. The Office admits that Hardt does not disclose "the rebound of the first pad differing from the rebound of the second pad," Office Action mailed 9/13/2007 at p. 3, but alleges that "Santiyanont discloses using [a] midsole/insole with first and/or second pad where the rebound of the first pad differing from the rebound rate of the second pad to provide a variable yet large range of cushioning effects, which is necessary for use in different sports activity (see column 4, lines 63-68 and column 5, lines 1-4 and table 3)," *id.* The Office argues that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the rebound properties of Hardt's pads as taught by Santiyanont to provide a variable yet large range of cushioning effects *in different parts of the footwear*, which is necessary for use in different sports activity and yield only predictable results." *Id.* (emphasis added). The Office restates the argument by concluding that Hardt discloses the rebound of first and second pads differing from the rebound of an insole (carrier), that Santiyanont discloses using pads with different rebound properties to provide a variable range of cushioning effects, and that "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices *in the same way*, using the technique is obvious...." *Id.* at p. 4 (emphasis added).

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Neither Santiyant '056 nor the combination describe or suggest an insole combining multiple elastomeric pads having different rebound properties

In responding to the Applicants' prior arguments, the Office states they are not persuasive because one cannot show non-obviousness by attacking references individually. *Id.* at p. 4. This statement mischaracterizes the Applicants' argument as a rebuttal rather than an argument against the sufficiency of the alleged *prima facie* case for obviousness. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2142.03. In this regard, the Office admits that Hardt '203 does not disclose the rebound of the first pad differing from the rebound of the second pad. Therefore arguments directed to the absence of such matter in Santiyant '056 serve to establish that the claim limitation is not described or suggested by Santiyant '056 nor present in the hypothetical combination of the Hardt '203 publication and Santiyant '056. MPEP § 2145 and the caselaw cited by the Office do not pertain to the present point of dispute.

The Office cites to column 4, lines 63-68 and column 5, lines 1-4 and table 3 of Santiyant '056 in support of its allegation that the reference discloses first and second pads where the rebound of the first pad differs from the rebound of the second pad. We note that the cited disclosure describes the testing of various specimens of elastomers and provides a table listing various elastomer properties, but fails to describe or suggest that multiple different elastomeric pads should be combined within a single insole. A mere list of elastomers describing relevant property measurements is not sufficient. MPEP 2143.01(III); *KSR v. Teleflex, Inc.*, slip op. at 14 ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.").

The Office makes reference to the purposes discussed in col. 1 ll. 36-44 and col. 2 ll. 10-25 of Santiyant '056. However the Applicants respectfully continue to argue that while the reference discloses multiple elastomer materials having different rebound properties, the reference does not itself describe or suggest the manufacture of an insole combining multiple

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elastomeric pads having different ranges of hardness and different rebound properties, but only the manufacture of a line of insoles including multiple elastomeric pads having the same properties, with multiple variations of such insoles being manufactured to provide a range of cushioning effects. Response filed 6/27/2007 at pp. 8-9. Because the issue was raised during the interview conducted 11/2/2007, we further note that Hardt '203 similarly describes multiple elastomer materials, Hardt '203 at ¶0028, but again describes lines of insoles that are manufactured by pouring a single elastomeric mixture into heel openings 23 or 33 and arch openings 25 or 35, Hardt '203 at ¶0029, and teaches that "the same gel can be used for the heel plug, arch plug and arch cushion," *id.* at ¶0048. Therefore neither reference, either alone or in combination, provides a disclosure of or suggestion to create an insole for footwear (or a sole for footwear) including first and second elastomeric pads having differing rebound properties that are combined within the same device.

The rationale cited by the Office does not satisfy the requirements of KSR

The Office's argument concludes that "it would have been obvious... to modify the rebound properties of Hardt's pads as taught by Santianont to provide a variable yet large range of cushioning effects *in different parts of the footwear...*," Office Action mailed 9/13/2007 at p. 3 (emphasis added). However, we respectfully argue that there is no support for the contention that either Santianont '056 or Hardt '203 or the combination thereof would lead a person of ordinary skill in the art to vary the properties of only one of two (or more) included elastomeric pads, in that neither of the references discuss or suggest that the elastomeric pads be manufactured to have differing rebounds. Even in constructing a *prima facie* case for obviousness, the Office may not simply reach conclusions based on its own understanding or experience, or on its assessment of what would be basic knowledge or common sense, but must point to some concrete evidence in the record in support of its findings. *In re Zurko*, 258 F.3d 1371, 1385 (Fed. Cir. 2001). This burden was not altered by the Supreme Court's decision in *KSR*, which was based on a developed evidentiary record that included (1) an adjustable pedal

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structure whereby, when the pedal location is adjusted, one of the pedal's pivot points stays fixed; (2) a patent disclosing a pedal with an electronic sensor on a pivot point in the pedal assembly; and (3) a patent teaching that sensors should be put on a fixed part of a pedal assembly, so that it would be obvious to combine an adjustable pedal assembly with a fixed pivot point with a pivot-mounted pedal position sensor. *See KSR*, slip op. at pp. 6-7. No such connecting logic is provided in the evidence that the Office has cited to date. Thus the present rejections under § 103 are deficient and must be withdrawn.

The Office subsequently restates the argument, particularly discussing the existence of different rebounds between carrier and elastomeric pads in the Hardt devices and the disclosure of pads with differing rebound properties in the Santianont test results, and concluding that "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices *in the same way*, using the technique is obvious...." Office Action mailed 9/13/2007 at p. 4 (emphasis added). However, we respectfully argue that because both Hardt '203 and Santianont '056 are directed to lines of insoles that are manufactured with elastomeric pads having the same properties, and do not describe or suggest that multiple different elastomeric pads should be combined within a single insole, the Office cannot properly suggest that modifying only one of the elastomeric pads or modifying both of the elastomeric pads but with elastomers having different properties constitutes improving a similar device *in the same way* as discussed in *KSR*.

Rejection of claims 11, 17-18, 37, and 40-41 under § 103(a) over the Hardt '203 publication in view of Santianont '056

As argued previously, the Office has not established a prima facie case for the obviousness of these claims because it provides no factual basis for the rejection. *See Zurko*, 258 F.3d at 1385. Neither the cited portions of Santianont nor the combination of the Hardt '203 publication and Santianont '056 reference disclose, teach, or suggest that it would be desirable to provide an insole component including combining multiple and different elastomeric pads where the first pad

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rebound is greater than the second pad rebound. The Office has failed to respond to this argument. In the absence of factual evidence placed in the record, e.g. *see* MPEP §§ 2143, the rejection of the cited dependent claims is deficient, and it is not the Applicants' burden to disprove the Office's apparent argument that "the rebound of an article may be tuned to meet the needs of a particular user and/or a particular activity" may be used to reject a claim limitation that does not rely upon a range, but upon a qualitative difference between the properties of two distinct elements within said article, i.e., first and second elastomeric pads in an insole or sole for footwear.

Conclusion

In view of the foregoing remarks, the Applicants respectfully submit that the claims are allowable over the art of record and pray for a prompt allowance. The Commissioner is authorized to charge any additional fees required or to credit any overpayment to Deposit Account No. 20-0809.

Respectfully submitted,

/David R. Jaglowski/
David R. Jaglowski
Reg. No. 58,514

THOMPSON HINE LLP
P.O. Box 8801
Dayton, Ohio 45401-8801
Telephone: (937) 443-6600
Facsimile: (937) 443-6635
E-mail: IPGroup@ThompsonHine.com
506804.1